The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte NORIMITSU SAITO and MING ZHAO

Appeal No. 2005-1442
Application No. 09/734,786

ON BRIEF

Before ELLIS, SCHEINER, and GRIMES, Administrative Patent Judges.

GRIMES, Administrative Patent Judge.

DECISION ON APPEAL

This appeal involves claims to a method of introducing a nucleic acid into a subject by modifying and transplanting hair follicles. The examiner has rejected the claims as nonenabled. We have jurisdiction under 35 U.S.C. § 134. Because the examiner has not shown that undue experimentation would have been required to practice the claimed method, we reverse.

Background

The specification discloses that "histocultured tissues, including tissues containing hair follicles, can be successfully modified genetically ex vivo and then transplanted successfully into an intact mammalian subject. The success of the

modification is enhanced by treating the histocultured tissues with collagenase prior to genetic modification." Pages 2-3.

The specification states that

> [a]lthough it is advantageous to treat the cultured tissue with collagenase in order to enhance the ability of the tissue to accept heterologous nucleic acids, the treatment is not so severe as to destroy completely the integrity of the three-dimensional array.
>
> The three-dimensional histoculture can be assembled from any tissue, including skin, especially skin containing hair follicles, lymphoid tissue, or tumor tissue. The choice of tissue will depend on the nature of the treatment contemplated. . . .
>
> For example, hair follicles are useful recipients of genes intended to affect the growth or quality of hair, but also are able to produce immunogens and other products that may be useful to the organism taken as a whole.

Page 4.

The specification provides a working example in which DNA encoding green fluorescent protein (GFP) was introduced into hair follicles of histocultured mouse skin; the percentage of GFP-expressing hair follicles ranged from 22% to 67%. See pages 11-12. In a second working example, hair follicles in skin samples were transfected with GFP-encoding DNA and grafted onto recipient mice. The results showed that "the percentage of hair follicles with GFP fluorescence in collagenase-treated skin was 5.7 times greater than in hair follicles of untreated skin." Pages 14-15. Fluorescence was detected for at least 10 days after grafting. Figure 3B.

Discussion

1. Claim construction

Claims 1 and 11 are representative of the claims on appeal and read as follows:

1. A method to introduce a nucleic acid molecule into a mammalian subject which method comprises

transplanting into the dermis of said subject at least one hair follicle that has been modified ex vivo to contain said nucleic acid molecule.

11. A method to introduce a nucleic acid molecule into a mammalian subject which method comprises transplanting into the corresponding tissue of said mammal a histocultured intact tissue that has been modified ex vivo to contain said nucleic acid molecule;

wherein said histoculture has been treated with collagenase prior to modifying said tissue with the nucleic acid.

Thus, claim 1 is directed to a method of introducing a nucleic acid into a mammal by modifying a hair follicle ex vivo to contain the nucleic acid and transplanting the hair follicle to the mammal. Claim 1 does not explicitly require that the nucleic acid be expressed or provide any particular benefit to the mammal.

Claim 11 is similar to claim 1 but encompasses treating tissues other than hair follicles; in addition, claim 11 requires that the tissue be treated with collagenase before being modified with the nucleic acid.

2. Enablement

The examiner rejected claims 1-8, 11, 13-15, 17, and 19, all of the claims remaining, under 35 U.S.C. § 112, first paragraph, on the basis that the specification does not enable those skilled in the art to practice the claimed method without undue experimentation. The examiner considered the factors set out in In re Wands, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988), and concluded that

> [d]ue to the art recognized unpredictability of achieving therapeutic levels of gene expression following direct or indirect administration of nucleic acids and the lack of guidance provided by the specification for the parameters affecting delivery and expression of therapeutic amounts of DNA into the cells using ex vivo gene transfer into histocultured organs or tissues, it would require undue experimentation to practice the instant invention.

Examiner's Answer, page 10

Appellants argue that the claims are directed to a method of genetically modifying tissues ex vivo and transplanting the modified tissue into a subject, and therefore do not require achieving therapeutic levels of gene expression. Appeal Brief, page 5. Appellants point to the specification's discussion of prior art techniques and working examples as guidance to those skilled in the art. Appellants assert that "[t]he pending claims are fully supported by the ample amount of knowledge available in the relevant art when the present application was filed and the guidance provided in the specification." Id., page 7.

We agree with Appellants that the examiner has not adequately shown that undue experimentation would have been required to practice the claimed method. The examiner bears the initial burden of showing that a claimed invention is nonenabled. See In re Wright, 999 F.2d 1557, 1561-62, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993) ("[T]he PTO bears an initial burden of setting forth a reasonable explanation as to why it believes that the scope of protection provided by that claim is not adequately enabled by the description of the invention provided in the specification of the application.").

"[T]o be enabling, the specification of a patent must teach those skilled in the art how to make and use the full scope of the claimed invention without 'undue experimentation.'" In re Wright, 999 F.2d 1557, 1561, 27 USPQ2d 1510, 1513 (Fed.

Cir. 1993). "That some experimentation may be required is not fatal; the issue is whether the amount of experimentation required is 'undue.'" In re Vaeck, 947 F.2d 488, 495, 20 USPQ2d 1438, 1444 (Fed. Cir. 1991).

The enablement analysis must be focused on the product or method defined by the claims. "Title 35 does not require that a patent disclosure enable one of ordinary skill in the art to make and use a perfected, commercially viable embodiment absent a claim limitation to that effect." CFMT, Inc. v. Yieldup Int'l Corp., 349 F.3d 1333, 1338, 68 USPQ2d 1940, 1944 (Fed. Cir. 2003).

Here, the examiner has acknowledged that the claims are not limited to therapeutic methods, but argues that because therapeutic methods are encompassed by the claims, such methods must be enabled in order for the full scope of the claims to be enabled. See the Examiner's Answer, page 12.

The examiner's reasoning is logical but not entirely consistent with the case law: enabling the "full scope" of a claim does not necessarily require enabling every embodiment within the claim. See, e.g., Atlas Powder Co. v. E.I. Du Pont De Nemours & Co., 750 F.2d 1569, 1576, 224 USPQ 409, 414 (Fed. Cir. 1984): "Even if some of the claimed combinations were inoperative, the claims are not necessarily invalid. . . . Of course, if the number of inoperative combinations becomes significant, and in effect forces one of ordinary skill in the art to experiment unduly in order to practice the claimed invention, the claims might indeed be invalid." Atlas Powder concerned claims to a product, not a method as here, but the same principle applies – a claimed method does not lack enablement merely because it cannot be practiced under some circumstances or to achieve some particular result.

In re Cortright, 165 F.3d 1353, 49 USPQ2d 1464 (Fed. Cir. 1999), is instructive. In Cortright, the applicant claimed a method of "treating scalp baldness with an antimicrobial to restore hair growth." Id. at 1355, 49 USPQ2d at 1465. The Board reversed a rejection for lack of utility, but entered a new rejection for lack of enablement, on the basis that "restor[ing] hair growth" required returning the user's hair to its original state (a full head of hair). See id. "Because Cortright's written description discloses results of only 'three times as much hair growth as two months earlier,' 'filling-in some,' and 'fuzz,' the board reasoned, it does not support the breadth of the claims." Id. at 1358, 49 USPQ2d at 1467.

The court disagreed with the Board's claim interpretation, holding that "one of ordinary skill would construe this phrase [restoring hair growth] as meaning that the claimed method increases the amount of hair grown on the scalp but does not necessarily produce a full head of hair." Id. at 1359, 49 USPQ2d at 1468. The court concluded that the claims, so construed, were enabled. Id.

As with the present claims, the claims in Cortright encompassed a method of obtaining results that might be difficult to achieve: here, therapeutically effective gene therapy; in Cortright, complete restoration of hair growth. However, as in Cortright, the present claims do not require that particular result: the present claims require only introducing or delivering a nucleic acid; Cortright's claims required only some restoration of hair growth.

The court in Cortright did not dispute the Board's conclusion that completely restoring hair growth using Bag Balm® would require undue experimentation. See id. at 1357, 49 USPQ2d at 1467. The court nonetheless concluded that the claimed method

was not nonenabled merely because it encompassed one difficult-to-achieve outcome. The same reasoning applies here: the examiner may be correct that achieving clinically useful gene therapy using the claimed method would require undue experimentation, but the claims are not nonenabled merely for encompassing that difficult-to-achieve outcome.

The claims are directed to methods of introducing a nucleic acid into a mammalian subject or delivering a nucleic acid to a hair follicle or intact tissue. The examiner has not adequately explained why the specification does not enable those skilled in the art to introduce a nucleic acid into a mammalian subject, or deliver a nucleic acid to a hair follicle or intact tissue, without undue experimentation. We therefore reverse the rejection for nonenablement.

REVERSED

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